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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/070,496	07/12/2002	Roger Wayne Davies	9013-44	6949
20792	7590	10/22/2004	EXAMINER	
MYERS BIGEL SIBLEY & SAJOVEC PO BOX 37428 RALEIGH, NC 27627			SITTON, JEHANNE SOUAYA	
			ART UNIT	PAPER NUMBER
			1634	

DATE MAILED: 10/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/070,496

**Applicant(s)**

DAVIES ET AL.

**Examiner**

Jehanne S Sitton

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 37-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 37-67 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 37-38, drawn to a method of identifying genes suitable for the development of pesticides or cancer therapies by conducting plasmid rescue to isolate nucleic acids surrounding the site of transposon insertion.

Group II, claim(s) 39-44, drawn to a screening assay for identifying compounds which have a physiological effect on an organism by reacting a compound with a protein encoded by a nucleic acid selected from the group consisting of SEQ ID NOS 1-902 (this group is subject to further restriction, regarding nucleic acids, and a species election with regard to claim 44. See below).

Group III, claim(s) 45-46, drawn to a compound having modulatory activity on a protein identified by claim 39 (This group is subject to further restriction, regarding nucleic acids. See below).

Group IV, claim(s) 47, drawn to a pesticidally active compound identified by an assay according to claim 37.

Group V, claim(s) 48-52, drawn to a method of modulating the activity of a protein encoded by a gene comprising a nucleic acid selected from the group consisting of SEQ ID NOS 1-902 (This group is subject to further restriction, regarding nucleic acids. See below).

Group VI, claim(s) 54, drawn to a method of identifying compounds having pesticidal activity caused by modulation of a protein encoded by a nucleic acid selected from the group consisting of SEQ ID NOS 1-902 (This group is subject to further restriction, regarding nucleic acids. See below).

Group VII, claim(s) 55-56, drawn to a compound with pesticidal activity identified by the method of claim 54 (This group is subject to further restriction, regarding nucleic acids. See below).

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Group VIII, claim(s) 57, drawn to a method for producing a pesticidal composition according to claim 54 (This group is subject to further restriction, regarding nucleic acids. See below).

Group IX, claim(s) 58-66, drawn to a nucleic acid from the group consisting of SEQ ID NOS 430-783 and 899-902, vectors, host cells, method of producing a polypeptide and the polypeptide produced (This group is subject to further restriction, regarding nucleic acids. See below).

Group X, claim(s) 67, drawn to a method of identifying a polynucleotide selected from the group consisting of SEQ ID NOS 430-783 and 899-902 (This group is subject to further restriction, regarding nucleic acids. See below).

2. Additionally, groups II, III, and V-X named above are subject to further restriction.

Applicant is required to further elect a specific SEQ ID NO. This is NOT an election of species.

Nucleotide sequences encoding different proteins are structurally distinct chemical compounds

and are unrelated to one another. These sequences are thus deemed to normally constitute

independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to

the contrary, each such nucleotide sequence is presumed to represent an independent and

distinct invention, subject to restriction requirement pursuant to 35 USC 121 and 37 CFR 1.141.

By statute, “[i]f two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions.” 35

U.S.C. 121. Pursuant to this statute, the rules provide that “[i]f two or more independent and

distinct inventions are claimed in a single application, the examiner in his action shall require the applicant... to elect that invention to which his claim shall be restricted.” 37 CFR 1.142 (a). See

also 37 CFR 1.141(a). It is noted that searching more than one of the claimed patentably distinct sequences represents a serious burden for the office.

3. The inventions listed as Groups I-X, and the further sequence restriction do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: claim 58 is

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broadly drawn to fragments of a polynucleotide of any of SEQ ID NOS 430-783 or 899-902. Such recitation encompasses any 3mer nucleic acid which is taught by Brennan (US Patent 5,474,796). Accordingly, the claims lack the same or corresponding special technical feature over the prior art.

4. With regard to group II, this application contains a claim (claim 44) directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

kinase assays, protein phosphatase assays, adenyl cyclase assays; guanylyl cyclase assays; phosphodiesterase assays; nucleosidease assays; protease assays, protein secretion and/or import assays, nuclease assays; DNA metabolism assays; transcription factor assays; apoptosis assays; calcium utilisation assays; receptor/ion channel assays; and G protein assays.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

5. The claims are deemed to correspond to the species listed above in the following manner:

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Claim 44 is drawn to the patentably distinct species. Claim 43 is generic.

6. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: each assay requires a patentably distinct set of reagents and method steps for performing each assay that are not dependent on any other assay. Accordingly, there is no corresponding special technical feature linking the assay together.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jehanne Sitton whose telephone number is (571) 272-0752. The examiner can normally be reached Monday-Thursday from 8:00 AM to 5:00 PM and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion, can be reached on (571) 272-0782. The fax phone number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.



Jehanne Sitton  
Primary Examiner  
Art Unit 1634

10/18/04